UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,358	10/30/2001	Eiji Kawai	09812.0484-00000.	2712

22852 7590 03/08/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
PHAN, THANH S	

ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,358	KAWAI, EIJI	
	Examiner	Art Unit	
	Thanh S. Phan	2841	(

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 26-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 26-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8-12, 14, 26-28, 30-36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malcolm et al. [US 5,790,939] in view of Hepp et al. [US 6,449,219].

Regarding claims 1, 4, 8, 9-12, Malcolm et al. disclose a system [figure 1] for distributing watch information, and processing information comprising: a plurality of hand held terminal devices [22] that acquire and process said watch information including clock appearing data [time synchronization to display the correct time]; an information distribution apparatus [20] for distributing said watch information to said plurality of hand held terminal devices; and display means [64, figure 2]] for displaying said watch information on said plurality of hand held terminal devices; wherein said watch information is displayed on said display means of said plurality of hand held terminal devices that depicts at least a current time [not explicitly mentioned, however the timer 48 is capable of this function].

Malcolm et al. disclose the claimed invention except for the time is displayed in form of a video image.

Hepp et al. discloses a system and method for customizing time display including language, multi media/video [column 1, lines 55-67; fig. 1].

Since Malcolm et al. and Hepp et al. are from the same field of endeavor in the field of horology, the purpose disclosed by Hepp et al. would have been recognized in the pertinent art of Malcolm et al.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the display design system and/or method of Hepp et al. with Malcolm et al. for the purpose of presenting a unique and personalized time display sequence on a display device.

Regarding claim 2, Malcolm et al. disclose wherein the handheld devices comprising a smart card [64, figure 2] capable of storing and/or carrying information and insertable into the handheld devices.

Regarding claims 3, 14, Malcom et al. disclose wherein the watch information are distributed as data to the plurality of hand held device by using broadcast infrastructure and/or communication infrastructure [satellite].

Regarding claim 5, Malcolm et al. disclose an operating section [22 figure 2] operated to input operational information concerning the watch information; a receiving section [44] that receives the watch information; a storage device [66] that stores the watch information received by the receiving section; and a control unit that reads out the watch information from the storage device according to the operational information.

Regarding claim 6, Malcolm et al. disclose that the handheld terminals are hand held phone set [22] comprising a turner [44] that received watch information form a

broadcast station [satellite 26]; a storage device [66] that stores the watch information received by the turner; a data processing section [22] that reads out and processes the watch information stores in the storage device; and a hand held telephone function [59, 60] controlled by the data processing section.

Regarding claims 26-28, 30-36 and 38, the method steps are necessitated by the disclosed apparatus structure.

Claims 7 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malcolm et al. and Biggs as applied to claim 1 above, and further in view of Kawamoto et al. [US 6,889,246].

Regarding claim 7, Malcolm et al., as modified, disclose the claimed invention wherein the device is capable of accepting a recording medium [smart card] except for explicitly describe that the recording medium provides the watch information to a user, and wherein the user mounts the information recording medium on a hand held terminal device to use the watch information via the recording medium.

Kawamoto et al. disclose a data distribution system wherein a memory card [112] for recording data is mounted to a cellular phone [31].

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the teachings of Hori et al. with Malcolm et al., as modified, to facilitate recording/transferring/reproducing watch information to a plurality of devices.

Regarding claim 29, the method steps are necessitated by the disclosed apparatus structure.

Claims 13 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malcolm et al. and Biggs as applied to claim 1 above, and further in view of Lim [US 6,628,974].

Regarding claim 13, Malcolm et al., as modified, disclose the claimed invention except for the hand held devices are foldable type.

Lim discloses a hand held device is a foldable type [fig. 5].

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the foldable design of Lim with the devices of Malcolm et al., as modified, for the purpose of providing components protection.

Regarding claim 37, the method steps are necessitated by the disclosed apparatus structure.

Response to Arguments

Applicant's arguments filed 12/20/05 have been fully considered but they are not persuasive. The applicant has emphasized the scope of the Remarks on the two independent claims 1 and 26. Applicant argues that the prior art of record fails to disclose the claimed invention in the above claims. Examiner disagrees:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the utilization of providing the customizing time display to tell time in a device(s) that capable of time telling, such as Malcolm, is indeed taught by Hepp. In addition, the applicant argues that Malcolm fails to disclose "the watch information including clock appearance data". The examiner disagrees and repeats his assertion that Malcolm demonstrates such information, because in the time synchronization data comprises information necessary for the corrected time to appear on the device/clock. Applicant also argues about the display means 64. Applicant merely claimed a means **for** displaying, and means 64 is capable of such as demonstrated in figure 2 wherein "display" is connected. Furthermore, it is old and well known for mobile terminal such as cell phones to comprise a display panel/screen to display information.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh S Phan whose telephone number is 571-272-2109. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tsp

K Cuco
SPE 2841